62

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IN THE

Supreme Court of the United States

ITC LIMITED,

Petitioner,

v.

PUNCHGINI, INC., RAJA JHANJEE, PARAGNESH DESAI, VICKY VIJ, DHANDU RAM, MAHENDRA SINGH, BACHAN RAWAT, BUKHARA GRILL II, INC.,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF OF *AMICUS CURIAE* AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PETITIONER

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TABLE OF CONTENTS

Page

STATEMENT OF INTEREST 1

SUMMARY OF ARGUMENT..... 1

ARGUMENT..... 4

I. Review by This Court Would Resolve Conflicts Between the Second Circuit Decision and Other Circuits..... 4
   A. The General Principle of Territoriality..... 4
   B. The Well-Known Marks Doctrine..... 5
   C. Circuit Conflict..... 6

II. The Second Circuit's Decision Raises Issues of Exceptional Importance..... 8
   A. The Doctrine Implicates the Core Purposes of the Lanham Act..... 8
   B. The Decision Below May Place the United States in Non-Compliance with International Obligations and Would Undermine U.S. Negotiating Positions..... 10
      1. Recent International Obligations..... 11
      2. History of the Doctrine and its Importance to American Trademark Owners..... 13
   C. Incorporation of the Doctrine in Federal Law..... 17

III. Conclusion..... 20

TABLE OF AUTHORITIES

Cases: Page

A. Bourjois & Co. v. Katzel, 260 U.S. 689 (1923)..... 4

Aktieselskabet AF 21 v. Fame Jeans Inc., 2007 WL 1655877 (D.D.C. June 7, 2007)..... 10

All England Lawn Tennis Club (Wimbledon) Ltd. v. Creation Aromatiques, Inc., 220 U.S.P.Q. 1069 (T.T.A.B. 1983)..... 7

Almacenes Exito S.A. v. El Gallo Meat Mkt., Inc., 381 F. Supp. 2d 324 (S.D.N.Y. 2005)..... 9

De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc., 440 F. Supp. 2d 249 (S.D.N.Y. 2006)..... 9

Empresa Cubana Del Tabaco v. Culbro Corp., 70 U.S.P.Q. 2d 1640 (S.D.N.Y. 2004)..... 9

Grupo Gigante S.A. De CV v. Dallo & Co., Inc., 391 F.3d 1088 (9th Cir. 2004)..... 2, 7, 8-9

Hanover Star Milling Co. v. Metcalf, 240 U.S. 403 (1916)..... 19

Int'l Bancorp LLC. v. Societe Des Bains De Mer Et Du Cercle Des Etrangers A Monaco, 329 F.3d 372 (4th Cir. 2003)..... 9, 18

ITC Ltd. v. Punchgini, Inc., 482 F.3d 135 (2d Cir. 2007)..... 2, 6, 7, 9, 10

Maison Prunier v. Prunier's Rest. & Café, 288 N.Y.S.2d 529 (N.Y. Sup. Ct. 1936).... 6, 15

McDonald's Corp. v. Joburgers Drive-Inn Rest. (Pty) Ltd., 1997 (1) SA 1 (A) (S. Afr.)..... 16

Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 428 (2003)..... 8, 19

Mother's Rests., Inc. v. Mother's Other Kitchen, Inc., 218 U.S.P.Q. 1046 (T.T.A.B. 1983)..... 7

Murray v. Schooner Charming Betsy, 6 U.S. (2 Cranch) 64 (1804)..... 12

Persons Co. Ltd. v. Christman, 900 F.2d 1565 (Fed. Cir. 1990)..... 7

Qualitex Co. v. Jacobson Prods. Co., Inc., 514 U.S. 159 (1995)..... 8

Two Pesos, Inc. v Taco Cabana, Inc., 505 U.S. 763 (1992)..... 19

United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918)..... 4

Vaudable v. Montmarte, Inc., 193 N.Y.S.2d 332 (N.Y. Sup. Ct. 1959)..... 6, 7, 16

Vimar Seguros y Reaseguros, S.A. v. M/V Sky Reefer, 515 U.S. 528 (1995)..... 12

Statutes:

15 U.S.C. § 1051..... 2

15 U.S.C. § 1125(a)..... 14,17

15 U.S.C. § 1125(c)..... 5

15 U.S.C. § 1126(e)..... 5

15 U.S.C. § 1141h..... 5

United States-Singapore Free Trade Agreement Implementation Act, Pub. L. No. 108-78, 117 Stat. 948 (2003)..... 12

Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994)..... 20

Treaties and Agreements:

Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299 ..... 6, 13, 15

Free Trade Agreement, U.S.-Jordan, Oct. 4, 2000, http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Jordan/asset_upload_file250_5112.pdf. 11-12

Free Trade Agreement, U.S.-Korea, June 1, 2007, http://www.ustr.gov/Trade_Agreements/Bilateral/Republic_of_Korea_FTA/Draft_Text/Section_Index.html..... 12

Free Trade Agreement, U.S.-Sing., May 6, 2003, http://www.ustr.gov/Trade_Agreements/Bilateral/Singapore_FTA/Section_Index.html..... 11

Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, adopted by Assembly of the Paris Union for the Protection of Industrial Property and General Assembly of the World Intellectual Property Organization, WIPO Doc. 833(E) (Sept.1999)..... 11

Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised at Stockholm, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305..... 4, 13, 14

Legislative History:

H.R. Rep. No. 104-374 (1995), *as reprinted in* 1996 U.S.C.C.A.N. 1029..... 12-13

S. Rep. No. 79-1333 (1946), *as reprinted in* 1946 U.S.C.C.A.N. 1274..... 8, 10

S. Rep. No. 103-412 (1994). 19-20

Miscellaneous:

J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant is Now Awake*, 59 J. LAW & CONTEMP. PROB. 45 (1996)..... 19

5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2007)..... 5, 18, 19, 20

Frederick W. Mostert, *International Recognition and Protection of Famous Marks*, in FAMOUS AND WELL KNOWN MARKS (Frederick W. Mostert ed., 2d ed. 2004)..... 9, 14

G.H.C. BODENHAUSEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (1968)..... 14

Global Brands Scorecard 2006, Business Week, Aug. 7, 2006..... 16

Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law From the Nation State*, 41 HOUS. L. REV. 885 (2004)..... 5, 14

Ludwig Baeumer, *International Legislative History, within the Framework of WIPO, of the Recognition and Protection of Famous and Well-Known Marks*, in FAMOUS AND WELL KNOWN MARKS (Frederick W. Mostert ed., 2d ed. 2004)..... 14

Office of the U.S. Trade Rep., 2007 "Special 301" Report (Apr. 30, 2007),http://www.ustr.gov/assets/Document_Library/Reports_Publications/2007/2007_Special_301_Review/asset_upload_file643_11122.pdf..... 15

STATEMENT OF INTEREST[1]

The American Intellectual Property Law Association (the "AIPLA") is a national bar association of more than 16,000 members with interests and practices primarily in the areas of trademark, copyright, trade secret, patent and other areas of intellectual property law. Unlike areas of practice in which separate and distinct plaintiff's and defendant's bars exist, most intellectual property law attorneys represent both intellectual property owners and alleged infringers.

The AIPLA has no interest in any party to this litigation or stake in outcome of this case, other than its interest in seeing a correct and consistent interpretation of the law affecting trademarks and unfair competition.

In accordance with Supreme Court Rule 37.2(a), the AIPLA has obtained written consent to the filing of this brief from the counsel of record for both parties. The letters of consent have been filed with the Clerk of the Court.

SUMMARY OF ARGUMENT

Under the traditional view of the territoriality principle, priority of rights in the

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[1] In accordance with Supreme Court Rule 37.6, the AIPLA states that this brief was not authored, in whole or in part, by counsel to a party to the instant Petition, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the AIPLA or its counsel.

United States depends solely upon use in U.S. commerce. The well-known marks doctrine, properly applied, would provide an exception to this general rule and protect a foreign mark that is well-known but not used in the United States. In *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 165 (2d Cir. 2007), a panel of the Second Circuit refused to recognize such a doctrine notwithstanding that "a persuasive policy argument can be advanced in [its] support." This decision conflicts directly with the decision of the Court of Appeals for the Ninth Circuit in *Grupo Gigante S.A. De CV v. Dallo & Co., Inc.*, 391 F.3d 1088 (9th Cir. 2004), which recognized the well-known marks doctrine.

Whether federal law recognizes the "well-known marks" doctrine presents an extremely important issue of trademark and unfair competition law. The well-known marks doctrine helps to effectuate the purposes of the Lanham Act, 15 U.S.C. § 1051 *et seq.* Rigid application of the general principle of territoriality absent a well-known marks exception would permit deception of American consumers about the goods and services offered to them in the United States. The well-known marks doctrine also ensures that mark owners are protected against opportunistic appropriation of marks by pirates in markets in which the mark owner has established a reputation but has not yet made commercial use of its mark. In short, both substantive objectives of the Lanham Act are furthered by recognition of the doctrine.

Moreover, Congress attempted through the Lanham Act to create nationwide protection for

trademarks, consistent with international obligations undertaken by the United States. The decision of the Second Circuit would render protection of well-known marks a matter of state law, disrupting the goal of uniform nationwide protection.

It also would put the United States at odds with its international obligations. And failure to recognize the well-known marks doctrine would also undermine efforts of the United States government in international negotiations to secure reciprocal protection in foreign countries for owners of well-known American marks. Specifically, the United States has committed itself to the protection of well-known foreign marks that have not been used in the United States in return for a commitment by foreign nations that well-known American marks that have not been used or registered in foreign countries will be protected there against appropriation by local pirates.

From the perspective of producers, the well-known marks doctrine is particularly important in countries operating a registration-based (as opposed to use-based) trademark system, which includes most countries other than the United States. The doctrine also tends to be of special significance to multinational brand owners. As a result, international recognition of the doctrine is critical to American interests.

The AIPLA takes no position on which party should prevail in this case if a federal well-known marks doctrine is recognized by this Court. Instead, the AIPLA urges the Court to grant the

petition for certiorari and to hold that the general principle of territoriality in trademark law is subject to an exception in which protection is afforded to a foreign mark which, though not used in the United States, is proven to be well-known here.

ARGUMENT

I. Review by This Court Would Resolve Conflicts Between the Second Circuit Decision and Other Circuits

A. The General Principle of Territoriality

Trademark rights are territorial. *See A. Bourjois & Co. v. Katzel*, 260 U.S. 689, 692 (1923). This bedrock principle of U.S. law is fully consistent with the Paris Convention for the Protection of Industrial Property ("Paris Convention"), the leading international trademark treaty. *See* Paris Convention for the Protection of Industrial Property, arts. 6(1), 6(3), Mar. 20, 1883, as last revised at Stockholm, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 (recognizing the principle of territoriality).

Although most countries in the Paris Union grant rights to the first person to *register* a mark, under U.S. law, the first person to *use* a mark generally obtains superior rights in that mark. *See United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918). Courts have held that the plaintiff's use must be a "use in commerce" in order to create common law trademark rights in the

United States. As discussed below, *see infra* pages 17-19, the text of the Lanham Act arguably is more expansive than currently recognized by case law, but the general rule is well-accepted. Thus, use of a mark in another country typically does not create trademark rights in the United States. *See* 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 29:2, at 29-7 (2007) ("Priority of trademark rights in the United States depends solely upon priority of use in the United States, not on priority of use anywhere in the world").

B. The Well-Known Marks Doctrine

There are exceptions to the rule that trademark rights can only be acquired in the United States after the mark in question has been used here. For example, both Sections 44 and 66 of the Lanham Act provide means for foreign mark owners to acquire U.S. rights to marks that are not yet used in the United States. *See* 15 U.S.C §§ 1126(e), 1141h (2006). The well-known marks doctrine,[2] as understood by the United States government and U.S. courts recognizing the

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[2] Among U.S. courts and commentators, the doctrine is often alternatively called the "famous marks" doctrine. Because the term "famous mark" has become a term of art in trademark dilution law, *see* 15 U.S.C. § 1125(c) (2006), courts and litigants often confuse the two concepts. Yet, the concepts of protection against dilution and protection for well-known marks are quite different. See Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law From the Nation State*, 41 HOUS. L. REV. 885, 926-927 (2004). For that reason, we use the term "well-known mark" in this brief.

doctrine, is also an exception to this general rule. Under that doctrine, a foreign mark that is well-known but not used in the United States is protected against unauthorized uses here by third parties that are likely to cause confusion.

C. Circuit Conflict

In the court below, a panel of the Second Circuit held that federal trademark and unfair competition law did not recognize a "well-known marks" exception to the principle of territoriality. *ITC*, 482 F.3d at 165. The panel acknowledged that the doctrine was recognized in both Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement, see Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299 ("TRIPS Agreement"), but found that the Lanham Act provided no basis on which to recognize it. *Id.* at 161-163. In light of this conclusion, the court was not willing to develop the doctrine as a matter of policy notwithstanding that "a persuasive policy argument can be advanced in [its] support." *Id.* at 165. Instead, the panel found that any case law recognizing the doctrine simply reflected the law of the State of New York, *see Maison Prunier v. Prunier Rest & Café*, 159 Misc. 551, 288 N.Y.S.2d 529 (N.Y. Sup.Ct. 1936), *Vaudable v. Montmarte, Inc.*, 20 Misc.2d 757, 193 N.Y.S.2d 332 (N.Y. Sup. Ct. 1959), and was grounded in common law principles of unfair competition. *See ITC*, 482 F.3d at 157-158.

The Second Circuit's decision creates a direct conflict with the decision of the Court of Appeals

for the Ninth Circuit in *Grupo Gigante*, 391 F.3d at 1094 (recognizing well-known marks doctrine), and arguably with the position adopted by the Court of Appeals for the Federal Circuit. *See Persons Co. Ltd v. Christman*, 900 F.2d 1565, 1569-1570 (Fed. Cir. 1990) (noting case law finding bad faith sufficient to defeat the rights of the first user in the United States as against a foreign mark owner "where (1) the foreign mark is famous here or (2) the use is a nominal one made solely to block the prior foreign user's planned expansion into the United States") (citing, *inter alia, Vaudable*, 20 Misc. 2d at 757); *see also The All England Lawn Tennis Club (Wimbledon) Ltd. v. Creation Aromatiques, Inc.*, 220 U.S.P.Q. 1069, 1072 (T.T.A.B. 1983); *Mother's Rests., Inc. v. Mother's Other Kitchen, Inc.*, 218 U.S.P.Q. 1046, 1048 (T.T.A.B. 1983).

The Ninth Circuit in *Grupo Gigante* found solid support for the doctrine within the general purposes of the Lanham Act:

> While the territoriality principle is a long-standing and important doctrine within trademark law, it cannot be absolute. An absolute territoriality rule without a famous-mark exception would promote consumer confusion and fraud. Commerce crosses borders. In this nation of immigrants, so do people. Trademark is, at its core, about protecting against consumer confusion and "palming off." There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the

store they liked back home.

Grupo Gigante, 391 F.3d at 1094.

II. The Second Circuit's Decision Raises Issues of Exceptional Importance

A. The Doctrine Implicates the Core Purposes of the Lanham Act

When Congress enacted the Lanham Act, it identified two primary justifications for trademark protection: to "protect the public so that it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and which it wants to get"; and to ensure that "where the owner of a trademark has spent energy, time and money in presenting to the public the product, he is protected in his investment from its appropriation by pirates and cheats." S. Rep. No. 79-1333, at 3 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1277. These purposes, drawn from the common law of trademarks that Congress was largely codifying, continue to guide the development of federal trademark and unfair competition law. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-164 (1995) (Breyer J.); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (Stevens J.).

These substantive purposes are implicated by the well-known marks doctrine. The potential protection for consumers was acknowledged both by the Ninth Circuit in recognizing the doctrine and

the Second Circuit in rejecting it. *See Grupo Gigante*, 391 F.3d at 1094 ("there can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home"); *ITC*, 482 F.3d at 165 (noting that "a persuasive policy argument can be advanced in support [of the doctrine]"); *see also International Bancorp LLC v. Societe Des Bains De Mer Et Du Cercle Des Etrangers A Monaco*, 329 F.3d 372, 381-82 (4th Cir. 2003) (noting that the doctrine recognizes the undesirability of domestic confusion resulting from use of foreign marks). Clearly, the doctrine serves to protect mark owners against appropriation of goodwill by pirates and opportunists.

The importance of the well-known marks doctrine to the ability of U.S. trademark law to vindicate these purposes has increased of late. *See* Frederick W. Mostert, *International Recognition and Protection of Famous Marks*, §§ 1-1 to 1-4, in FREDERICK W. MOSTERT, FAMOUS AND WELL KNOWN MARKS (2d ed. 2004). In an era of enhanced digital communications technologies, widespread international travel, global trade, and fluid immigration patterns, rigid application of the general principle of territoriality would lead to the confusion of American consumers. It is not surprising, therefore, that the number of cases in which this doctrine is invoked is rising. *See, e.g., De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc.*, 440 F. Supp.2d 249 (S.D.N.Y. 2006); *Almacenes Exito S.A. v. El Gallo Meat Market, Inc.*, 381 F. Supp.2d 324 (S.D.N.Y. 2005); *Empresa Cubana Del Tabaco v. Culbro Corp.*, 70

U.S.P.Q.2d 1640 (S.D.N.Y. 2004), *rev'd in part on other grounds*, 399 F.3d 462 (2d Cir. 2005); *Aktieselskabet AF 21 v. Fame Jeans Inc.*, 2007 WL 1655877 (D.D.C. June 7, 2007).

The well-known marks doctrine also affects other objectives that Congress sought to pursue in adopting the Lanham Act. The Lanham Act sought to facilitate enforcement of rights on a national, rather than local, basis partly because commerce was becoming more national. *See* S. Rep. No. 79-1333, at 4, *reprinted in* 1946 U.S.C.C.A.N. at 1277. Yet, the decision of the Second Circuit would imperil such uniformity, making well-known marks protectable only under laws of various states. *See ITC*, 482 F.3d at 160.

B. The Decision Below May Place the United States in Non-Compliance with International Obligations and Would Undermine U.S. Negotiating Positions

The Lanham Act was also an attempt to implement international obligations under trademark treaties and thus secure reciprocal benefits abroad for American traders. *See* S. Rep. No. 79-1333 at 3, *reprinted in* 1946 U.S.C.C.A.N. at 1276. Recent international obligations assumed by the United States mandate a well-known marks doctrine that protects marks without use in the United States. If the decision of the Second Circuit is correct, the United States may be subject to accusations that it is in breach of those obligations. Moreover, that decision would undermine the efforts of the United States government in

international negotiations to secure reciprocal protection for owners of well-known American marks in foreign countries.

1. Recent International Obligations

The United States has assumed international obligations to protect well-known marks that are not used in U.S. commerce by ratifying bilateral trade agreements that call for recognition of the well-known marks doctrine. In 2001, the World Intellectual Property Organization ("WIPO") General Assemblies and the Paris Union agreed to a "Joint Recommendation on Well-Known Marks", which stipulates that a well-known mark will be protected in a specific country on the ground that it is well-known in that country, even if the mark is neither registered *nor* used there. *See* Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, *adopted by* Assembly of the Paris Union for the Protection of Industrial Property *and* General Assembly of the World Intellectual Property Organization, WIPO Doc. 833(E), art. 2(3)(i) (Sept. 1999) (hereinafter "Joint Recommendation on Well-Known Marks").

The U.S. government has since included compliance with the Joint Recommendation as a term in at least two bilateral trade agreements. *See, e.g.*, Free Trade Agreement, May 6, 2003, U.S.-Sing., art. 16.1(2)(b)(i) (providing that each party shall give effect to the Joint Recommendation on Well-Known Marks), http://www.ustr.gov/Trade_Agreements/Bilateral/Singapore_FTA/Section_Index.html; Free Trade Agreement, Oct. 24, 2000, U.S.-

Jordan, art. 4(1)(a)(same), http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Jordan/asset_upload_file250_5112.pdf. Although these agreements are not directly effective in U.S. law, *see, e.g.*, United States-Singapore Free Trade Agreement Implementation Act, Pub. L. No. 108-78, § 102(a), 117 Stat. 948 (2003), courts should hesitate before construing U.S. domestic law as inconsistent with the international obligations of the United States. *See Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64 (1804).

Moreover, ensuring effective protection for well-known marks remains a key part of the trade policy of the United States. For example, in the most recently concluded bilateral trade agreement with the Republic of Korea, the parties elaborated upon the operation of the doctrine in a number of ways designed to ensure its fullest possible effectiveness. *See* Free Trade Agreement, June 1, 2007, U.S.-Korea, art. 18.2(6), at http://www.ustr.gov/Trade_Agreements/Bilateral/Republic_of_Korea_FTA/Draft_Text/Section_Index.html. Obviously, the U.S. government's efforts to negotiate international protection of well-known marks would be seriously undermined if our own laws are construed as denying such protection. *See Vimar Segurosy Reaseguros, S.A. v. M/V Sky Reefer*, 515 U.S. 528, 539 (1995) ("If the United States is to be able to gain the benefits of international accords and have a role as a trusted partner in multilateral endeavors, its courts should be most cautious before interpreting its domestic legislation in such a manner as to violate international agreements"); *see also* H.R. Rep. No. 104-374, at 4 (1995), *reprinted*

in 1996 U.S.C.C.A.N. at 1029, 1030 (suggesting that passage of the federal dilution law would "assist the executive branch in its bilateral and multilateral negotiations with other countries to secure greater protection for the famous marks owned by U.S. companies.").

2. History of the Doctrine and its Importance to American Trademark Owners

The genesis of the well-known marks doctrine is Article 6*bis* of the Paris Convention. That article requires member states,

> [a]t the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.

Paris Convention, art. 6*bis*; *see also* TRIPS Agreement, art. 16(2) (extending protection to well-known service marks).

Because the text of Article 6*bis* mandated protection only for well-known marks that had not been *registered* in the country where protection was sought, the provision imposed minimal obligations on the United States. In the United States, the

protection of marks used but not registered here was largely accomplished by the availability of protection for unregistered marks in Lanham Act Section 43(a). *See* 15 U.S.C. § 1125(a)(1)(A) (2006).

At the 1958 Revision Conference of the Paris Union, the United States proposed expanding Article 6*bis* to mandate protection for well-known marks that had been neither *used* nor registered in the country where protection was sought. See Ludwig Baeumer, *International Legislative History, within the Framework of WIPO, of the Recognition and Protection of Famous and Well-Known Marks*, in MOSTERT, at §§ 3-1, at 3-9. Although that proposal was defeated, the narrow margin of defeat (only 2 nay votes out of 27 votes cast) suggested that most countries would protect well-known marks without use in their country. *See* G.H.C. BODENHAUSEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY 91 (1968) (predicting in 1968 that "the great majority of member states will probably adopt this attitude"). And many countries now do so. *See* Mostert, at §§ 1-33 to 1-34 n.91 (listing case law from several countries). The Paris Convention only imposes minimum obligations, and member states are thus free to protect well-known marks without local use. *See* Dinwoodie, *Trademarks and Territory*, 41 Hous. L. Rev. at 913.

Indeed, the first courts in the United States to apply the well-known marks doctrine exceeded what was *required* under the Paris Convention in other respects. International law mandated

protection for well-known *service* marks (as distinguished from trademarks) only in 1994, when the TRIPS Agreement strengthened the protection for well-known marks, *see* TRIPS, art. 16(3), and explicitly extended protection to well-known service marks, *see id.* art. 16(2). Yet, U.S. courts had long protected well-known service marks. *See, e.g., Maison Prunier*, 288 N.Y.S.2d 529; *Vaudable*, 193 N.Y.S.2d 332.

The United States has encouraged other nations to protect well-known American marks that have not been used or registered in foreign countries against appropriation by local pirates. *See* Office of the United States Trade Representative, 2007 Special 301 Report 48 /April 30, 2007/ /commending the Chinese courts for recognizing KODAK as a well-known mark/, http://www.ustr.gov/assets/Document_Library/Reports_Publications/2007/2007_Special_301_Review/asset_upload_file643_11122.pdf. The well-known marks doctrine is of particular importance to American trademark owners seeking to market goods in countries operating a registration-based /as opposed to use-based/ trademark system. In those countries, an opportunistic local party can secure priority over the American owner of the well-known mark by the simple and cheap option of registering. The well-known marks doctrine protects the true mark owner in these situations. For example, it is the well-known marks doctrine that thus protected the ability of the McDonald's Corporation to expand its business into South Africa notwithstanding registration of the McDONALD'S

mark by local "entrepreneurs." *See McDonald's Corp. v. Joburgers Drive-Inn Rest. (Pty) Ltd.*, 1997 (1) S.A. 1 (A) (S. Afr.). This doctrine also prevented Russian pirates who had registered the mark STARBUCKS in Russia from extorting $600,000 from the American coffee company when it contemplated opening there. *See* 5 MCCARTHY, § 29.61 at 29-176 n. 6 (reporting Russian litigation). If other countries impose a local use requirement, U.S. businesses would suffer.

The well-known marks doctrine also tends to be of special significance to multinational or global brand owners. As a result, international recognition of the doctrine is particularly important to American interests. *See The Global Brands Scorecard 2006*, Business Week, Aug. 7, 2006, also available at http://www.finfacts.ie/brands.htm (noting that American brands occupy "7 of the top 10 brands in a ranking of 'global brands,'" a category requiring *inter alia*, that the "brand . . . have a minimum brand value of US$2.7 billion, achieve about one third of [its] earnings outside of [its] home country, . . . and have a wider public profile beyond [its] direct customer base"). Even well-known marks may not be used everywhere, and registration in all countries can be financially prohibitive; trademark owners often delay the expense of registering their marks in places not presently used until they have plans to expand their business into those countries.

C. Incorporation of Doctrine in Federal Law

Application of the well-known marks doctrine is encompassed by the literal language of Section 43(a), the principal unfair competition provision in the Lanham Act.[3] Section 43(a) provides that:

> Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
>
> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .

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[3] The Second Circuit concluded that, although the doctrine might be consistent with the purpose of the Lanham Act, it was for Congress to make the statutory amendments necessary to recognize the doctrine. But the language of Section 43(a) clearly admits recognition of the doctrine, as Congress has no doubt assumed in enacting a number of reforms designed to preserve the position of the United States as the leading advocate of international trademark protection without specifically referencing the well-known marks doctrine in a separate statutory provision.

> . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1)(A) (2006).

Some courts have held that in order to bring an infringement claim in the U.S. courts, a plaintiff must show that it has made prior use of the mark in the United States. However, there is no statutory basis for this requirement in an action under Section 43(a). *See* 5 MCCARTHY, § 29:2, at 29-10 n.10. Instead, use in the United States (or more strictly, "use in commerce,") is an explicit element essential only of a *defendant's* allegedly infringing use.

Thus, as Professor McCarthy has noted, a literal reading of Section 43(a) clearly allows room for the protection of marks that are well-known in the United States even if they have not been used in this country. *See* 5 MCCARTHY, at § 29:4 at 29-21 ("Lanham Act § 43(a) gives a foreign national without a federal registration of its mark standing to sue in a federal court [and] invoke the well-known marks doctrine of the Paris Convention Article 6bis"); *cf. Int'l Bancorp*, 329 F.3d at 382 (Luttig C.J.) ("Ultimately, though, if [plaintiff's] mark merits protection under the statute, we must provide it to them. We do not know that this is 'reverse imperialism,' but we do know that . . . if such owners, upon their petition, can demonstrate that they meet the requirements of the statute, that they are then *entitled* to protection, and that it is beyond us to refuse it to them") (emphasis in original).

Moreover, this reading of Section 43(a) is fully consistent with the common law relationship between trademark and unfair competition law. "[T]he common law of trademarks is but a part of the broader law of unfair competition," *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916), and the Lanham Act reflects this fact. *See Moseley*, 537 U.S. at 428 (Stevens J.) ("Traditional trademark infringement law is a part of the broader law of unfair competition, that has its sources in English common law, and was largely codified in the Trademark Act of 1946") (citations omitted), *Two Pesos, Inc. v Taco Cabana, Inc.*, 505 U.S. 763, 787 (1992) (Thomas J., concurring) (noting that protection should be available for conduct coming within the scope of the text of Section 43(a) without regard to the provisions of the Lanham Act that deal with registration).[4]

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[4] The Lanham Act may also be seen to have incorporated the well-known marks doctrine through Section 44. *See* 5 MCCARTHY, § 29:61, at 29-177 (concluding that the international obligation to protect well-known marks "is enforced in the United States by Lanham Act § 44(b) and § 44(h)"); *cf. id.* § 29:4, at 29-20 to 29-21 (also relying on Section 43(a)). Although Section 44 is clearly one of the provisions by which Congress sought to implement our country's international obligations, the precise rights conferred by section 44 are unclear. *See* J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant is Now Awake*, 59 J. LAW & CONTEMP. PROB. 45, 48-50 (1996). Alternatively, some might argue that the international instruments discussed above may have introduced the doctrine directly into U.S. law. *See* 5 MCCARTHY, at § 29:61-62, at 29-166 to 29-176 to -177 ("There is no doubt that both the TRIPS Agreement and the Paris Convention Article 6*bis* require the United States to recognize rights in an unregistered mark if the mark is so well-known that confusion is likely to result."). However, there is

III. Conclusion

For the foregoing reasons, the AIPLA respectfully requests that the Court grant certiorari to review the Second Circuit panel's decision. The Court should grant that review to clarify that the well-known marks doctrine is recognized under federal trademark and unfair competition law.

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substantial disagreement in the lower courts as to whether the Paris Convention is self-executing, *see generally* 5 MCCARTHY, at 29:33 at 29-88 to -94, and as discussed above that treaty did not in any event mandate that the well-known marks doctrine protect marks that have been neither registered nor used in a particular country. The TRIPS Agreement is not self-executing. *See* S.Rep. No. 103-412, at 13 (1994); Uruguay Round Agreements Act, Pub.L. No. 103-465, 108 Stat. 4809 (1994).